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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,805	09/23/2004	Zenon Lysenko	61829	6216
109 7590 06/07/2007 THE DOW CHEMICAL COMPANY INTELLECTUAL PROPERTY SECTION, P. O. BOX 1967 MIDLAND, MI 48641-1967			EXAMINER CARR, DEBORAH D	
			ART UNIT 1621	PAPER NUMBER
			MAIL DATE 06/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/508,805

Applicant(s)

LYSENKO ET AL.

Examiner

Deborah D. Carr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-44 is/are allowed.
- 6) ☒ Claim(s) 11-42 and 49-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. The finality of the office action dated 14 December 2006 has been withdrawn. The After-Final amendment filed 8 February 2007 will be entered and has overcome the rejection of record. Therefore, the rejection has been withdrawn.

Allowable Subject Matter

2. The indicated allowability of claims 7-51 is withdrawn. A new rejection follows below.

Claim Objections

3. Claims 7-10 are objected to as being drawn to compounds in the context of a product-by-process claim format. The objection is based on the fact that the compounds produced by the process are definite as to their meaning. As such, claims to the compounds can stand-alone. Product-by-process claim language is reserved for situations where the compound cannot be claimed in a definite manner. The instant application does not fall into this category, as the compounds are definite. Further, there is no showing that the process of making imparts new and unobvious properties to the compounds themselves.

Therefore, product-by-process claims 7-10 will be treated as compound claims for the purpose of this examination.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 7-10, 45-48 rejected under 35 U.S.C. 102(b) as being clearly anticipated by DE-4,107,056 or WO-96/04289.

DE'056 teaches an olefin metathesis process and fatty acid ester composition comprising an unsaturated C14 fatty acid methyl ester composition showing no metathesis catalysts poisons (see examples 1, 3, 4).

WO'289 teaches an olefin metathesis process and fatty acid ester composition comprising a fatty acid methyl ester composition showing no metathesis catalysts poisons using oleic acid and ethylene (see page 17, paragraph 9).

Applicant has previously argued the absence or silence of the presence of poisons in both references is not adequate support for them not being present in the compounds/compositions taught and the presence of these poisons inherently exists just by the natural of the reaction.

However, the presence of poisons is due to oxidation of the unsaturated compounds by oxygen contained in the air. As shown in all of the examples wherein an ester was produced, the vial was capped while in a nitrogen-filled glove box therefore no poisons were presented resulting in less than 3 meq of metathesis catalyst poisons. It should also be noted

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purification is taught when the reaction environment is conducted in the presence of oxygen. WO'289 provides for the reduction of metathesis catalyst poisons in the reaction product and the esters taught via this reaction process anticipates the instant invention.

Like wise, DE'056 conducts the reaction under argon eliminating any presence of oxygen and production of metathesis catalyst poisons. See examples 1-4.

The comparative data presented by applicants was reviewed and was found to be lacking in overcoming the rejection. The large amounts of catalyst referred to by applicants fall within the ranges taught in the instant invention. Therefore is unclear how WO'289 and DE'056 used of "large amounts" of catalyst results in unacceptable catalyst activity and high levels of poisons.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-42, 49-51 rejected under 35 U.S.C. 103(a) as being unpatentable over WO-96/04289.

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Concerning the metathesis process claims 11-23, WO'289 represents the closest prior art and differs from the matter of claim 11 insofar that the feature of "feedstock composition derived from a seed oil" is not disclosed.

The process for the preparation of a polyester polyepoxide according to claims 24-28 differs from the closest prior art of WO'289 in the feature "feedstock composition derived from a seed oil". The polyester polyolefin composition according to claims 29, 30 as well as the polyester polyepoxide composition (claims 31, 32). The process of preparing a reduced chain α,ω -hydroxy -acid, -ester and/or -diol (claims 33-36), the α,ω -polyester polyol composition (claims 37-38), a process of preparing a reduced chain α,ω -amino acid, α,ω -aminoester and/or α,ω -amino alcohol (claims 39-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the metathesis process disclosed in WO'289 as examples 6-9 on pages 16-17 to obtain the instant process. WO'289 uses methyl oleate and oleic acid as reactants instead of the feedstock cited in the claims. These fatty acids/esters are contained in any "feedstock composition derived from a seed oil." Therefore, whether they are contained in a feedstock or as singular acids, the reaction still results in the same product an olefin derived from a metathesis process.

The mere use of different starting materials, whether novel or known, in a conventional process to produce the product one would expect therefrom does not render

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the process unobvious. Use of a known member of a class of materials in a process is not patentable if other members of the class were known to be useful for that purpose. Once the general reaction has been shown to be old, burden is on the applicant to present reason or authority for believing that a group on the starting compound would take part in or affect the basic reaction and thus alter the nature of the product or operability of the process.

Allowable Subject Matter

8. Claims 43-44 are allowed.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D. Carr whose telephone number is 571-272-0637. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

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(toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DEBORAH D. CARR
PRIMARY EXAMINER

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